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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,953	11/19/2003	Donald J. Palmer	200312665-1	9024
22879	7590	10/06/2006	EXAMINER	
HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			NGUYEN, LAMSON D	
			ART UNIT	PAPER NUMBER
			2861	

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

A

Office Action Summary	Application No. 10/717,953	Applicant(s) PALMER ET AL.	
	Examiner Lamson D. Nguyen	Art Unit 2861	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment dated 07/21/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 10-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Byers et al. (6,378,976).

Byers et al teach a printing method comprising:

Claim 1:

- Designing a pattern with at least one area for receiving writing indicia (column 3, lines 49-51 teaching printing of images or text which inherently that a certain pattern of data to be printed has to be processed according to print data in order for printing to take place; column 9, claim 2 teaches “step of printing a predetermined pattern in predetermined target areas on a print medium”)
- assigning the pattern to the medium, wherein the pattern defines coordinates of the medium (column 9, claim 2 teaches “step of printing a predetermined pattern in predetermined areas on a print medium)

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- applying a fixer to the medium forming a substantially invisible pattern
(column 4, lines 30-35 teach printing with a fixer on a medium, inherently teaching that a predetermined area or pattern to where a fixer is applied; column 4, line 11 teaches a colorless fixer, therefore teaching an colorless or invisible pattern)

Claim 2:

- designing a layout of a document (it is an inherent feature that printing physically takes place in a layout withing a medium, otherwise it would be printing off the medium; column 3, line 49 teaches a "printzone"; column 2, lines 53-55)
- preparing an image of the layout of the document for printing (it is an inherent feature that image is processed for printing; column 3, lines 32-33 teach controllers for printing purposes)
- applying ink to the medium to form the image (column 4, lines 1-5)

Claim 3:

- applying the fixer to the medium before applying ink to the medium (column 4, lines 32-35 teach fixer may be applied before or after)

Claim 4:

- applying the ink to the medium before applying the fixer to the medium
(column 4, lines 32-35 teach fixer may be applied before or after)

Claim 5:

- mixing an infrared marker or an ultraviolet marker with the fixer (column 4, lines 38-48)

Claim 6:

- wherein the fixer is capable of fluorescing or acting as an attenuating filter of fluorescence when exposed to a predetermined wavelength of electromagnetic radiation (column 4, lines 57-65)

Claim 8:

- wherein preparing the image of the layout of the document for printing comprises configuring software associated with a computer to prepare the image of the layout of the document for printing (column 3, lines 32-33 teaches a computer peripheral)

Claim 9:

- wherein preparing the image of the layout of the document for printing comprises configuring firmware to prepare the image of the layout of the document for printing (figure 1, column 3, lines 32-35)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Byers in view of Takeuchi et al. (6,134,025).

Byers et al teach all claimed features of the invention except 1-bit plane of data of image.

It is well-known to have 1-bit plane of image data in the art, as taught by Takeuchi et al (figure 4, 1-bit data 36).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Byers to incorporate the teaching of 1-bit plane image data for the purpose of producing black and white image.

Response to Arguments

Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

On page 7 of the arguments, paragraph 4, the applicants argue that Byers does not teach "designing a pattern with at least one area for receiving writing indicia". The examiner disagrees. As stated in the rejection above, the examiner asserts that it is inherent and well-known in the art that any printing apparatus has a capacity and ability to "design a pattern". Specifically, the printing apparatus must be able to "design" a pattern to print in accordance with print data. The applicants further argue that Byers does not teach a pattern with at least one area for receiving writing indicia. Again, the examiner disagrees. In claim 2, column 9, Byers clearly teaches "a predetermined pattern in predetermined target areas on a blank print medium". Finally, the applicants argue that Byers' fixing liquid is geared towards printing a test pattern. This is true, however, all the applicants claim in claim 1 is "applying a fixer to the medium forming a substantially invisible pattern", which is exactly what Byers is doing. The applicants did not specifically exclude the use of the fixing liquid for printing a test pattern in the claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

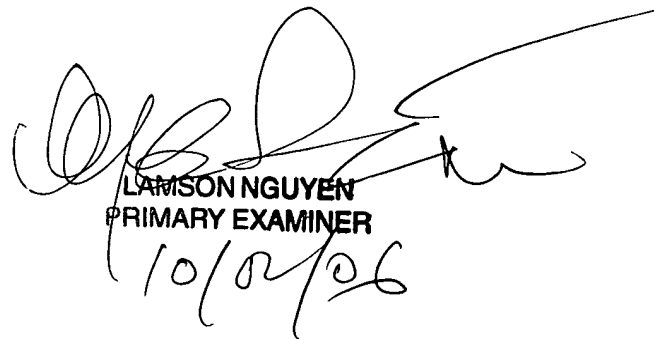
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lamson D. Nguyen whose telephone number is 571-272-2259. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vip Patel can be reached on 571-272-2458. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LAMSON NGUYEN
PRIMARY EXAMINER
10/04/06